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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/849,400	05/07/2001	Ai J. Lin	P66823US0(WRAIR-01)	9445

7590

06/13/2003

Office of the Staff Judge Advocate
U.S. Army Medical Research and Materiel Command
ATTN: MCMR-JA (Ms. Elizabeth Arwine)
504 Scott Street
Fort Detrick, MD 21702-5012

EXAMINER

PATEL, SUDHAKER B

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 06/13/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/849,400

Applicant(s)
A.J. Lin et al

Examiner
SUDHAKER PATEL, D.Sc. Tech.

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1624



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on May 6, 2003
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 32, 33, and 49-56 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 32 and 33 is/are rejected.
- 7) ☒ Claim(s) 49-56 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other: _____

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DETAILED ACTION

Response to Amendment

Applicants' communication paper \$ 20 dated 5/6/03 is acknowledged.

I.

Election/Restriction

Because applicants did not distinctly and specifically point out the supposed errors in the restriction/election requirement, the election has been treated as an election without traverse(MPEP 818.03(a)).Applicants have elected invention of Group I for further prosecution.

The restriction/election is considered proper and is now made FINAL..

Upon further review and consideration, this application is not ready at this stage for allowance for the reasons stated bellow.

II. Rejections withdrawn:

Applicants' arguments and remarks to gather with claims as now presented (as amended and new), are sufficient for withdrawal of rejections made under 35 U.S.C. 112 para second.

III. New Rejections:

Claim Rejections - 35 U.S.C. § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 32,33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cusic J.W.

(U.S.P. 2687414 dated 8/1954).

Applicants are claiming a compound having a core:

Phenothiazine, 10-[3-(1-pyrrolidinyl)butyl]-, its compositions either simple or binary with other anti-malarials and the utility as a method of treating malaria.

The ref. '414 teaches making of Phenothiazine, 10-[3-(1-pyrrolidinyl)propyl]-. See Example 24 lines 54-65 in column 8. The ref. Also teaches the use of such compounds as histamine antagonists and antispasmodic agents.

Thus, it would have been obvious to one having ordinary skill in the art at the time of invention to prepare instant compounds by modifying alkylpropyl bridge of the ref. '414 core: "(Ar)(R)N-Alk-B" wherein B = pyrrolidine; (Ar)(R)N- making a tricyclic heterocycle ring (=cyclic amine/ phenothiazine) and also to try out the use/utility as a pharmaceutical by using the conventional chemistry knowledge. The motivation stems from the expectation of making compounds having equal or better medicinal agent, and finally combine the same with other available pharmaceuticals for making improved antimalarial.

Analogous alkyl variations would be structurally obvious. See, In re Dillon, 919 F. 2d at 1904. See also Deuel, 51 F. 3d at 1558, 34 U.S.P.Q. 2d at 1214 ("Structural relationships may provide the requisite motivation or suggestion to modify one compound to obtain another compound(s)"). For example, one compound may suggest its homolog, because homolog often

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have similar properties, and therefore, chemists of ordinary skill would ordinarily contemplate making them to try to obtain compounds with improved properties, or merely to satisfy their production goals.

Claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F. 2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). See also MPEP 2141.02.

It has been held that a prior art disclosed compounds is sufficient to render a prima facie case of obviousness as species falling within a genus. See In re SUSI, 440 F 2d 442, 169 USPQ 423, 425 (CCPA 1971), followed by Federal Circuit in Merck & co. V. Biocraft Laboratories, 847 F 2d 804, 10 USPQ 2d 1843, 1846 (Fed. Cir.1989). See In re Dillon 16 USPQ 2nd. 1897, 1923 regarding a prima facie case of obviousness of structurally similar compounds disclosed by prior art" regardless to the properties disclosed in the inventor's application.

IV.

Conclusion

Allowable Subject Matter

Method of use claims 49-51 and composition claims 52-56 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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The claims would be considered for allowance as the references disclosing the homologous compounds do not teach antimalarial activity. Therefore, there is no motivation to use them as antimalarial as such or to combine them with other antimalarial.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sudhaker Patel, D.Sc. Tech. whose telephone number is (703) 308 4709.

The examiner can normally be reached on Monday thru' Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by the phone are unsuccessful, the examiner's supervisor, Dr. Mukund Shah can be reached at (703) 308 4716 or Sr. Examiner Mr. Richard Raymond at 703 308 4523.

A facsimile center has been established for Group 1600. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machine are (703) 308-4556 or (703) 305-3592.

S.p.

June 12, 2003.


Mukund Shah

SUPERVISORY PATENT EXAMINER

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